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OFFICE OF PETITIONS

In re Application of	:
Baur et al.	:
Application No. 08/627,386	: Decision on Petition for
Filed: April 4, 1996	: Patent Term Extension
Attorney Docket No. MERCK-1753D	:
For: LIQUID CRYSTAL DISPLAY	:
DEVICES HAVING A PARALLEL	:
ELECTRIC FIELD AND WHICH < 30	:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition Under 37 CFR 1.181," which was received on March 26, 2005, for the above-identified application. See 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701.

The petition is dismissed.

Petitioner notes that the above-identified application was filed on April 4, 1996, a Notice of Appeal was filed on November 21, 2001, an Appeal Brief was filed on February 28, 2002, and the Board of Patent Appeals and Interferences (BPAI) reversed the decision of the Examiner on November 22, 2004. Petitioner argues that the Notice of Allowance and Issue fee mailed on January 27, 2005, improperly failed to include a patent term extension of 1098 days. Petitioner asserts that the application is entitled to 1098 days of patent term extension and that the terminal disclaimer filed on June 4, 1999, in response to the obvious double patenting rejection in view of U.S. Patent No. 5,576,867 is not the type of terminal disclaimer specified in 35 U.S.C. 154. Petitioner argues that the statutory exclusion for patent term extension for terminal disclaimers is opposite to the usual kind of terminal disclaimer, which is filed due to a double patenting situation where and application's subject matter is patentably indistinct from that claimed in an issued patent. Petitioner argues that the statute is only applicable when a terminal disclaimer is filed in a two-way test, double patenting scenario. Petitioner argues that this application could not have been subject to the two-way test, thus it must have been the one-way test and therefore the application is entitled to 1098 days of patent term extension.

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)

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(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

The above-identified application was filed on November 22, 1995, which is after June 8, 1995 and before May 29, 2000, and, as a result is an application that may be eligible for patent term extension under 35 U.S.C. § 154. While the application was issued pursuant to an adverse determination of patentability by the BPAI, the application is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct.

On November 30, 1998, the examiner made a double patenting rejection in view of U.S. Patent No. 5,576,867 stating the claims if allowed, would improperly extend the right to exclude already granted in the patent. The examiner stated that U.S. Patent No. 5,576,867 covered the subject matter claimed in the instant application. In response, the terminal disclaimer was filed on June 4, 1999. With respect to Petitioner's argument that the exclusion in 35 U.S.C. § 154 for terminal disclaimers only applies to situations in which the two-way test applies is not persuasive. There is nothing in the statutory language with respect to the one-way or two-way test. The statute states that a "patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review" and the patent that is to be issued is subject to a terminal disclaimer.

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

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